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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,568	11/06/2003	James R. DeFrancesco	104570-498-DIV	8714
7590 Richard I. Samuel Goodin Procter LLP 103 Eisenhower Parkway Roseland,, NJ 07065			EXAMINER NGUYEN, NGA B	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 10/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/702,568

Applicant(s)

DEFRANCESCO ET AL.

Examiner

Nga B. Nguyen

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3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/22/05; 7/23/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communication filed on November 6, 2003, which paper has been placed of record in the file.
2. Claims 1-22 are pending in this application.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-22 are rejected on the ground of nonstatutory double patenting over claims 1-8 of U. S. Patent No. 7,181,427 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A system and method for receiving and routing credit application information comprising the steps of: receiving a credit application form at least one remote application input location; selectively forwarding said received credit application to one or funding sources; receiving a funding decision and content from said one more funding sources, etc...

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-11 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The claims, as presently claimed and best understood were reconsidered in light of the "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

As to claims 1-11, the claimed invention is implemented as Functional Descriptive Material *Per Se*. "A computer program product" is a Functional descriptive material.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer

efficiency) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory)

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

In this case, "A distributed computer program product having a plurality of program steps" recited in claims 1-11, is not embodied in any computer-readable media. Therefore, for the reason set forth above, claims 1-11 are non-statutory, because they are directed solely to Functional Descriptive Material *Per Se*.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-11, the word "means" is preceded by the words "for receiving", "for forwarding", "for delivering", in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claims 1-11 are **ambiguous** because they include both product and process. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett et al (hereinafter Bennett), U.S. Patent No. 6,603,487.

Regarding to claim 12, Bennett discloses a system for providing a closed loop credit decision process for a consumer at a dealer web site, said system comprising:

a communications medium (figure 1 and column 2, lines 18-25, Internet hub 12 with radial electronic links to dealer work stations 14 and financial institutions 16);

a host system to implement and control an interactive credit application and routing system; said host system connected to said communications medium (column 6, lines 48-62, Credit Server transfers data from the dealership to and from the financial institutions);

a dealer web site, said dealer web site connected to said communications medium; said dealer web site for providing a credit application to be completed by a consumer and for forwarding a completed credit application to said host system together with information that identifies said dealer (figure 1 and column 2, lines 27-55, dealer work stations 14 transfer credit application over the Internet to a server);

a plurality of funding sources connected to said communications medium (figure 1 and column 2, lines 18-25, financial institutions 16); and

wherein said host system configured for receiving said credit application from said dealer web site and for selectively forwarding said received credit application to one or more of said plurality of funding sources, for receiving a funding decision from

said at least one of said one or more of said plurality of funding sources; and for forwarding said received funding decision to said dealer web site (column 6, lines 48-62, Credit Server transfers data from the dealership to and from the financial institutions).

Regarding to claim 13, Bennett further discloses wherein said host further forwards said received funding decision to said dealer terminal (column 2, lines 43-50, credit decision is transmitted back to the dealer over the Internet).

Regarding to claim 14, Bennett further discloses wherein said host further forwards said received funding decision to said dealer by facsimile (column 6, lines 5-15, dealer submits a credit application both in E-mail and fax).

Regarding to claim 15, Bennett further discloses wherein said host further stores said received funding decision at said host (column 6, line 48-column 7, line 5).

Regarding to claim 16, Bennett further discloses wherein said host further generates lead information about said credit application process for dealer follow-up (column 7, lines 8-60, credit server stores contract, applications and other misc. forms).

Regarding to claim 17, Bennett further discloses wherein said lead information includes consumer contact information, vehicle information and information about whether the application process is complete or incomplete (column 7, lines 6-30, credit server stores contract, applications and other misc. forms).

Regarding to claim 18, Bennett further discloses wherein said host further receives and forwards contract information electronically to said at least one of said one or more of said plurality of funding sources for verification of said contract information (column 6, lines 48-62, Credit Server transfers data from the dealership to and from the

financial institutions).

Regarding to claim 19, Bennett further discloses wherein said dealer web site provides information about the status of said credit application (figure 10 and column 8, lines 23-28).

Regarding to claim 20, Bennett further discloses wherein said dealer web site provides authorized access to information about the status of said credit application (figure 10 and column 8, lines 23-28).

Regarding to claim 21, Bennett further discloses wherein said authorized access utilizes password information (figure 3 and column 8, lines 1-5).

Regarding to claim 22, Bennett further discloses wherein said host further forwards related disclosures together with said received funding decision to said dealer web site (column 6, lines 48-62, Credit Server transfers data from the dealership to and from the financial institutions).

Claims 1-11 contain similar limitations found in claims 12-22 above, therefore, are rejected by the same rationale.

Conclusion

11. Claims **1-22** are rejected.

12. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Tengel et al. (US 5,940,812) disclose apparatus and method for automatically matching a best available loan to a potential borrower via global telecommunications network.

Zandi (US 5,966,699) discloses system and method for conducting loan auction over computer network.

Jones et al. (US 5,797,133) disclose method for automatically determining the approval status of a potential borrower.

Davidson (US 5,699,527) discloses a loan processing system to aid a potential loan applicant preparing the necessary financial statement, loan application, and business plan to apply for a business loan.

Anderson et al. (US 5,774,883) disclose method for selecting a seller's most profitable financing program.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

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Or faxed to:


(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany
Street, Alexandria, VA, First Floor (Receptionist).


NGA NGUYEN
PRIMARY EXAMINER

September 19, 2007